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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,056	04/08/2004	Mauro Castiglioni	13607 US	2094
<div>23719 7590 10/25/2007 KALOW &amp; SPRINGUT LLP 488 MADISON AVENUE 19TH FLOOR NEW YORK, NY 10022</div>				
<div>EXAMINER GRAHAM, SHELLEY R</div>				
<div>ART UNIT PAPER NUMBER 4173</div>				
<div>MAIL DATE DELIVERY MODE 10/25/2007 PAPER</div>				

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/822,056

**Applicant(s)**

CASTIGLIONI ET AL.

**Examiner**

Shelley R. Graham

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 21-40 and 42-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Response to Applicants' Election/Restriction*

1. Applicants' election with traverse of Group II, claims 12-48, in the reply filed on 24 August 2007, is acknowledged. Claims 1-11, 21-40, and 42-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. It is noted that, while claims 21-40 and 42-48 are listed as part of the elected invention, they are withdrawn because they are drawn to nonelected species. No claims have been amended, added or canceled. Accordingly, claims 12-20 and 41 are examined on the merits herewith.
2. Regarding the restriction requirement, all of Applicants' arguments have been considered but are not persuasive of error. Applicants assert that Examiner has not met the burden of showing that the cosmetic compositions and methods of using them are independent and distinct, and that the cited references for one group would be the same for the other group.
3. Examiner respectfully maintains the reasoning set forth in the restriction requirement filed 24 July 2007. It is stated that inventions can be shown to be distinct if **either** or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product **or** (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h).
4. Examiner has shown, according to (2) above, that the product as claimed can be used in a materially different process of using that product. According to the instant specification, Applicants admit, on page 1, lines 21 thru 23, "Retinoic acid is a known molecule used for a

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very long time for the treatment of cutaneous ageing, acne, and dischomia". US patent 5,698,593 further supports the use of compositions comprising retinoic acid to treat acne. Additionally, the inventions as claimed have acquired a separate status in the art due to their recognized divergent subject matter, do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

5. In searching Group I above, for example, Examiner will be focusing on the patentability of a skin treatment method for a patient subject to signs of cutaneous aging, and not the method of preparing the cosmetic composition or the cosmetic composition itself. Conversely, in searching Group II, the Examiner will be focusing on the patentability of a cosmetic composition in the form of a self-curing mask, as well as it's preparation, and not a skin treatment method for a patient subject to signs of cutaneous aging.
6. The restriction requirement is maintained and is made final.

***Claim Rejections - 35 U.S.C. § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 12-20 and 41 are rejected under 35 U.S.C. 102(e) as being *anticipated* by Dole et al. (2003/0044366 A1).

9. The instant claims are related to a cosmetic composition in the form of a self-curing mask containing retinoic acid and a hydrophilic polymer, ie. polyvinyl alcohol, said composition being an aqueous composition.

10. Dole et al. teaches a composition for forming a cosmetic mask comprising at least one colorant and silica, wherein the composition is combined with water. The composition of the invention may include anti-acne agents, for example retinoic acid and anti-aging agents, for example tretinoin. If a peel off mask is desired, the composition of the invention may include a polymer. A typical polymer used in the invention includes polyvinyl alcohol. (See claim 1, and page 2, lines 25-29; page 3, lines 27-29; and page 4, lines 45-48).

### ***Claim Rejections - 35 U.S.C. § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
14. Claims 12-20 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dole et al. (PGP 2003/0044366 A1) and Ptchelintsev et al. (USPT 6,562,321).
15. The instant claims are related to a cosmetic composition in the form of a self-curing mask containing retinoic acid and a hydrophilic polymer, ie. polyvinyl alcohol, said composition being an aqueous composition.
16. Dole et al. teaches a composition for forming a cosmetic mask comprising at least one colorant and silica, wherein the composition is combined with water. The composition of the invention may include anti-acne agents, for example retinoic acid and anti-aging agents, for example tretinoin. If a peel off mask is desired, the composition of the invention may include a polymer. A typical polymer used in the invention includes polyvinyl alcohol. (See claim 1, and page 2, lines 25-29; page 3, lines 27-29; and page 4, lines 45-48).

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17. Ptchelintsev et al. teaches a topical composition comprising a de-pigmenting agent and a vehicle. Suitable vehicles include polyvinyl alcohol and water. The composition may further comprise conventional hypopigmenting agents, ie. retinoids, such as retinol or retinoic acid. The composition may take on the form of a mask. (See claim 1; column 3 lines 48-51 and lines 56-58; and column 3 line 66 – column 4 line 2).

18. It would have been obvious to one of ordinary skill in the art at the time of invention, given the teachings of Dole and Ptchelintsev et al., to include retinoic acid and a hydrophilic polymer in an aqueous composition to be used as a mask. Both references teach of the same invention as claimed by Applicants, thus providing the motivation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley R. Graham whose telephone number is 571-270-1563. The examiner can normally be reached on M-R 9am-3pm EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRG  
18 October 2007

 10/23/07  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER